

O-537-19

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No. 3262441
BY TERRY RICE-MILTON & WILLIAM JAMES LAUGHTON
TO REGISTER IN CLASS 41
THE TRADE MARK**

The Original Cupid's Inspiration

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No. 411873
BY PAUL SHANAHAN, ROBERT POOLE & PAUL THOMAS**

AND

IN THE MATTER OF REGISTRATION No. 2647437 FOR THE TRADE MARK

Cupids Inspiration

**STANDING IN THE NAMES OF
PAUL SHANAHAN, ROBERT POOLE & PAUL THOMAS**

AND

**IN THE MATTER OF A REQUEST FOR A DECLARATION
OF INVALIDITY THERETO UNDER No.502169
BY TERRY RICE-MILTON & WILIAM JAMES LAUGHTON**

BACKGROUND

1) On 10 October 2017, Terry Rice-Milton & William James Laughton (hereinafter RML) applied to register the trade mark The Original Cupid's Inspiration in respect of the following services in Class 41: Music concerts; Music entertainment services; Music festival services; Music performance services; Music performances; Music production; Musical concerts by radio; Musical concerts by television; Musical entertainment; Musical group entertainment services; Musical performances.

2) The application was examined and accepted, and subsequently published for opposition purposes on 15 December 2017 in Trade Marks Journal No. 2017/050.

3) On 8 March 2018 Paul Shanahan, Robert Poole & Paul Thomas (hereinafter the SPT) filed notice of opposition. SPT are the proprietors of the following trade mark:

Mark	Number	Dates of filing & registration	Class	Specification relied upon
Cupids Inspiration	2647437	02.01.13 24.05.13	41	Entertainment in the form of live musical performances; entertainment and musical services; production of music shows; production of musical works in a recording studio; recording of music; band performances

4) There is only a single ground of opposition. SPT contend that the marks of the two parties are very similar and that the services applied for are identical and/or similar to the services for which the earlier mark is registered. As such the mark in suit offends against Section 5(2)(b) of the Act.

5) On 4 April 2018 RML filed a counterstatement basically denying all the grounds of opposition. RML state that they were the founders of the group in 1963 and had some success in the charts in the late 60s. SPT were not in the original group and never recorded under the name. They state that SPT only joined the band when only one original member remained in the 1970s. They state that SPT are passing themselves off as the original band even to playing their hit songs and using the original record sleeves and videos of tv performances of which they were not part. RML did not seek proof of use.

6) By an application dated 14 June 2018, RML applied for a declaration of invalidity in respect of the registration shown in paragraph 3 above. The single ground is, in summary:

- a) RML contends that in the 1960s they started a group known originally as “The End” which then changed its name to “Cupid’s Inspiration” in 1968 just prior to releasing a single called “Yesterday has Gone”. The single reached number four in the charts. All subsequent records including LPs had the name “Cupid’s Inspiration featuring T Rice-Milton” upon them. RML contend that the original band disbanded in the 1970s. RML contended that their reputation is being undermined by SPT whom they describe as “just an ordinary pub band”. They contend that SPT are using images of the original band. RML contend that use of the mark in suit will offend against section 5(4)(a) of the Act.

7) SPT provided a counterstatement, dated 19 November 2018, in which it states that only two of the original members of the band performed upon a cover version of the song “Yesterday has Gone”. The two are named as Terry Rice-Milton and Roger Gray, all other contributions being by session musicians. They state that the band did not disband but simply evolved by adding new members as others left. SPT state that Laughton left in 1968 having been a member for three months whilst Milton left in 1970 having been a member for just two years. Roger Gray recruited Paul Shanahan and Robert Poole in late 1970 along with Martin Cure. The band has played over 2000 live UK and European performances as well as appearing on radio and releasing recordings in the subsequent years.

8) Both parties filed evidence and submissions; both sides seek an award of costs in their favour. Neither side wished to be heard in this matter

SPT’S EVIDENCE

9) SPT filed four witness statements. The first, dated 23 March 2019, is a joint statement by Paul Shanahan and Robert Poole (hereinafter S&P). These gentlemen are the guitarist and bass player in the band Cupid’s Inspiration. S&P state that they joined the band in 1971, by which time only Roger Gray remained from the original 1968 line-up, all the other original members had left or been sacked, including Jim Laughton who left in 1968 and Terry Rice-Milton who left in 1970. Contrary to the claims of RML the group did not disband but continued to function. As of 1971 the line-up consisted of Shanahan, Poole, Gray and Martin Cure. In 1972 Gray left the band and was replaced by another

drummer. In 1974 the band promoted the re-release of the 1968 recording and the follow up “My World” despite these songs being by the original group. In 1985 the band re-recorded “Yesterday has Gone” for a 60s compilation album. The band continued playing throughout the intervening years, and although S&P left in 1987, they were replaced and the band continued until 2003/4 when Martin Cure retired. In 2010 S&P restarted the band along with Paul Thomas and a new drummer. In 2014 Roger Gray re-joined the band as the drummer. The band continues to perform and trade to date.

10) In March 2014 SPT became aware that Mr Rice-Milton was using the name “Cupid’s Inspiration” and “The Original Cupid’s Inspiration” in relation to live performances. Following an exchange of legal letters Mr Rice-Milton (RM) gave an undertaking which stated: “Mr Rice-Milton is not trading and undertakes not in future to trade using any name or style that is an infringement of your client’s mark” [2647437]. In September 2015 RM breached this undertaking leading to further exchanges of legal letters resulting in RM’s representation writing to various promoters, venues and booking agents demanding that SPT have no right to use the mark in suit.

11) S&P state that the band’s website www.cupidsinspirationuk.com makes it clear that the band line up has changed over the years. It clearly shows that RM left the band 48 years ago and Jim Laughton left 50 years ago, having been with the band for only three months. They provide a number of exhibits which appear to corroborate the events set out in their statement.

12) The second, third and fourth witness statements are by Roger Gray and Martin Cure, who both played in the band and Roger Lomas a record producer. Gray and Cure confirm when they joined and left the band as well as confirming dates when other left the band as set out above. Mr Lomas confirms that in 1985 he produced a version of the song “Yesterday has Gone” performed by Cure, Poole, Shanahan and Brook which is still available on Amazon.

RML’S EVIDENCE

13) RML filed a witness statement, dated 20 March 2019, by Stuart Everett a Tax Director in Meyer Williams CA Ltd who represents Mr Rice-Milton and James Laughton. He does not provide a statement in the normal sense but a dossier with various submissions and exhibits. His main charge appears to be that the proprietors of the existing registration were not in the original line-up. He contends that a Beatles tribute band could not register the Beatles as a name even if Ringo was playing the drums. He also contends that the names of the various bands which were formed prior to

the change of name to Cupid's Inspiration such as "The Blue Sounds", "The Loose Ends", "The Ends", "The Age of Consent" and "Age with T-Rice-Milton" have to be taken into consideration. The various articles appear to confirm that Mr Laughton left the band in 1968 and Mr Rice-Milton left in 1970. It is also clear that the band continued playing until at least 1990 even though the article in which this is stated (see page 3) begins with the line of "After more than forty years Cupid's Inspiration are back on the road". Also included are the various group line ups through the years up to and including 1987 and acknowledges that the various line-ups were performing as Cupid's Inspiration although they are dismissed as a "covers group", playing pubs and holiday camps. It is stated that the original recordings were re-released on 7 inch and 12 inch vinyl, compilation albums, cassettes and CDs. This first happened in 1974 when the singles "Yesterday has Gone" and "My World" were re-released and they also featured upon a compilation album. In June 1982 royalties amounting to £20.58 were received.

SPT'S EVIDENCE IN REPLY

14) SPT filed a witness statement dated 15 May 2019, pointing out what it considered to be the many flaws in the evidence of RML.

15) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

16) I shall first deal with the invalidity action brought under section 47 which reads:

"47. - (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(2) The registration of a trade mark may be declared invalid on the ground-

- (a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or
- (b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2A) But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

- (a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,
- (b) the registration procedure for the earlier trade mark was not completed before that date, or
- (c) the use conditions are met.

(2B) The use conditions are met if –

- (a) within the period of five years ending with the date of the application for the declaration the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes –

- (a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and
- (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(2D) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Union.

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

(3) An application for a declaration of invalidity may be made by any person, and may be made either to the registrar or to the court, except that-

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(4) In the case of bad faith in the registration of a trade mark, the registrar himself may apply to the court for a declaration of the invalidity of the registration.

(5) Where the grounds of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made.

Provided that this shall not affect transactions past and closed.”

17) The only ground of invalidity is under Section 5(4)(a) which states as follows:

“5. (4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

18) Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

- (1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and
- (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House’s previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.”

19) Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

20) First, I must determine the date at which RML’s claim is to be assessed; this is known as the material date. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC as the Appointed Person considered the relevant date for the purposes of s.5(4)(a) of the Act and concluded as follows:

“39. In *Last Minute*, the General Court....said:

‘50. First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51. However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non-registered national mark before the date of filing, in this case 11 March 2000.’

40. Paragraph 51 of that judgment and the context in which the decision was made on the facts could therefore be interpreted as saying that events prior to the filing date were irrelevant to whether, at that date, the use of the mark applied for was liable to be prevented for the purpose of Article 8(4) of the CTM Regulation. Indeed, in a recent case before the Registrar, *J Sainsbury plc v. Active: 4Life Ltd* O-393-10 [2011] ETMR 36 it was argued that *Last Minute* had effected a fundamental change in the approach required before the Registrar to the date for assessment in a s.5(4)(a) case. In my view, that would be to read too much into paragraph [51] of *Last Minute* and neither party has advanced that radical argument in this case. If the General Court had meant to say that the relevant authority should take no account of well-established principles of English law in deciding whether use of a mark could be prevented at the application date, it would have said so in clear terms. It is unlikely that this is what the General Court can have meant in

the light of its observation a few paragraphs earlier at [49] that account had to be taken of national case law and judicial authorities. In my judgment, the better interpretation of *Last Minute*, is that the General Court was doing no more than emphasising that, in an Article 8(4) case, the *prima facie* date for determination of the opponent's goodwill was the date of the application. Thus interpreted, the approach of the General Court is no different from that of Floyd J in *Minimax*. However, given the consensus between the parties in this case, which I believe to be correct, that a date prior to the application date is relevant, it is not necessary to express a concluded view on that issue here.

41. There are at least three ways in which such use may have an impact. The underlying principles were summarised by Geoffrey Hobbs QC sitting as the Appointed Person in *Croom's TM* [2005] RPC 2 at [46] (omitting case references):

- (a) The right to protection conferred upon senior users at common law;
- (b) The common law rule that the legitimacy of the junior user's mark in issue must normally be determined as of the date of its inception;
- (c) The potential for co-existence to be permitted in accordance with equitable principles.

42. As to (b), it is well-established in English law in cases going back 30 years that the date for assessing whether a claimant has sufficient goodwill to maintain an action for passing off is the time of the first actual or threatened act of passing off: *J.C. Penney Inc. v. Penneys Ltd.* [1975] FSR 367; *Cadbury-Schweppes Pty Ltd v. The Pub Squash Co. Ltd* [1981] RPC 429 (PC); *Barnsley Brewery Company Ltd. v. RBNB* [1997] FSR 462; *Inter Lotto (UK) Ltd. v. Camelot Group plc* [2003] EWCA Civ 1132 [2004] 1 WLR 955: "date of commencement of the conduct complained of". If there was no right to prevent passing off at that date, ordinarily there will be no right to do so at the later date of application.

43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date

of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’ ”

21) The mark in suit was applied for on 2 January 2013, and that date is, therefore, the material date.

22) RML provided submissions that effectively amounted to the same message as that contained within the evidence filed. Namely that SPT were not part of the group which recorded “Yesterday has Gone”. Therefore they, and the various subsequent line-ups, have been passing themselves off as the original band. In short, every variation of the band since Mr Rice-Milton left in 1970 has been a tribute band. They also dispute the time spent by Mr Laughton in the band as they contend that playing under the various names prior to becoming Cupid’s Inspiration in 1968 should count. RML relied heavily upon the findings by Mr Hobbs in decision BL-O- 369-13 (*The Animals*) in their submissions. However, I do not believe that the instant case is on all fours with that decision by Mr Hobbs not least because the band appears to have continued for some considerable time after the departure of RML, whereas in *The Animals* case use of the name of the band was limited after the band split. I believe that the case quoted by Mr Hobbs in *The Animals* and referred to more recently in another Appointed Person decision is more relevant. In case BL-O-537-16 Ms Himsworth QC acting as the Appointed Person stated:

“36. As noted above in paragraph [40] of the Decision the Hearing Officer referred to the decision of Geoffrey Hobbs QC sitting as the Appointed Person in The Animals (above) and in particular to the proposition that goodwill belonged to the ‘last man standing’ a proposition which the Hearing Officer then went on to apply in the present case.

37. In paragraph [8] of the Decision of Mr Hobbs QC in The Animals he referred to his earlier decision in CLUB SAIL Trade Marks [2010] RPC 32 at paragraphs [26] to [28]. Those paragraphs state as follows (emphasis added):

26 This opens up the appeal to the extent that I am now required to determine the competing claims of the parties to proprietorship of the goodwill of the business appertaining to the signs in issue. Before doing so, **I make the general observation that goodwill can be and frequently is built up and acquired by means of economic activities carried out collectively. By using the word ‘collectively’ I am intending to refer to all of the various ways in which alliances may be formed between and**

among individuals or corporate bodies in pursuit of shared interests and objectives.

It is appropriate in this connection to refer to the following observations in the judgment of the Court of Appeal delivered by Hughes L.J. in *R v L(R) and F(J)* [2008] EWCA Crim. 1970; [2009] 1 Cr. App. R 16:

Unincorporated associations

11. There are probably almost as many different types of unincorporated association as there are forms of human activity. This particular one was a club with 900 odd members, substantial land, buildings and other assets, and it had no doubt stood as an entity in every sense except the legal for many years. But the legal description “unincorporated association” applies equally to any collection of individuals linked by agreement into a group. Some may be solid and permanent; others may be fleeting, and/or without assets. A village football team, with no constitution and a casual fluctuating membership, meeting on a Saturday morning on a rented pitch, is an unincorporated association, but so are a number of learned societies with large fixed assets and detailed constitutional structures. So too is a fishing association and a trade union. And a partnership, of which there are hundreds of thousands, some very large indeed, is a particular type of unincorporated association, where the object of the association is the carrying on of business with a view to profit.

12. At common law, an unincorporated association is to be distinguished from a corporation, which has a legal personality separate from those who have formed it, or who manage it or belong to it. The most numerous species of corporation is the limited liability company, but there are of course other types, such as chartered professional associations, local government bodies and indeed bishops. At common law, as the judge succinctly held, an unincorporated association has no legal identity separate from its members. It is simply a group of individuals linked together by contract. By contrast, the corporation, of whatever type, is a legal person separate from the natural persons connected with it.

13. This is an apparently simple legal dichotomy duly learned by every law student in his first year. But its simplicity is deceptive. It conceals a significantly more complicated factual and legal position.

14. As to fact, many unincorporated associations have in reality a substantial existence which is treated by all who deal with them as distinct from the mere sum of those who are for the time being members. Those who have business dealing with an unincorporated partnership of accountants, with hundreds of partners world-wide, do not generally regard themselves as contracting with each partner personally; they look to the partnership as if it were an entity. The same is true of those who have dealings with a learned society, or a trade union, or for that matter with a large established golf club. Frequently, as Lord Phillips of Worth Matravers C.J. pointed out in *R. v W. Stevenson & Sons* (a partnership and others) [2008] EWCA Crim. 273; [2008] 2 Cr. App. R. 14 (p.187) (at [23]) third parties will simply not know whether the organisation being dealt with is a company or some form of unincorporated association.

15. As to the law, it no longer treats every unincorporated association as simply a collective expression for its members and has not done so for well over a hundred years. A great array of varying provisions has been made by statute to endow different unincorporated associations with many of the characteristics of legal personality. Examples selected at random include the following. The detailed special rules for partnerships contained in the Partnership Act 1890 scrupulously preserve the personal joint and several liability of the partners (see ss.5-12), and the Law Commission recommendation in November 2003 (Law Com. No. 283) that a firm should have legal personality has not been implemented, but the partnership can sue or be sued in its firm name: see CPR 7.2A and 7PD5A.3, repeating a rule which has existed for more than a century. A trade union is, by statute, not a corporation: s.10(1) of the Trade Union and Labour Relations (Consolidation) Act 1992. But by the same section it can make contracts, sue and be sued in its own name,

and commit a criminal offence. In the case of learned societies and institutions, their property (if not vested in trustees) is by s.20 of the Literary and Scientific Institutions Act 1854 vested in their governing body, albeit that neither the institution nor the governing body is a corporation. Nor are these developments confined to the statutory. As long ago as 1901 the House of Lords held in *Taff Vale Railway v Amalgamated Society of Railway Servants* [1901] A.C. 426 that a trade union (unincorporated) could be sued in its own name despite the absence of any statutory provision permitting it. Lord Lindley observed (at 442) that the problem of how to adapt legal proceedings to unincorporated societies consisting of many members was by no means new, and that the rules of common law had had to be altered to meet them. Those several examples relate largely to civil liability, but as will be seen, there is a similar variety of provision dealing with criminal liability in the case of unincorporated associations. The judgment in that case related to the operation of the general rule that in any enactment passed after 1889 the word 'person' includes 'a body of persons corporate or unincorporate' unless the contrary intention appears: s.5 and Sch. 1, Interpretation Act 1978.

27 I consider that the starting point for the purposes of analysis in the present case is the general proposition that the goodwill accrued and accruing to the members of an alliance such as I have described is collectively owned by the members for the time being, subject to the terms of any contractual arrangements between them: *Artistic Upholstery Ltd v Art Forma (Furniture) Ltd* [2000] F.S.R. 311 at paras.31 to 40 (Mr. Lawrence Collins Q.C. sitting as a Deputy High Court Judge). **When members cease to be members of an ongoing alliance they cease to have any interest in the collectively owned goodwill, again subject to the terms of any contractual arrangements between them;** see, for example, *Byford v Oliver (SAXON Trade Mark)* [2003] EWHC 295 (Ch); [2003] F.S.R. 39 (Laddie J.); *Mary Wilson Enterprises Inc's Trade Mark Application (THE SUPREMES Trade Mark)* BL O-478-02 (20 November 2002); [2003] EMLR 14 (Appointed Person); *Dawnay Day & Co Ltd v Cantor*

Fitzgerald International [2000] R.P.C. 669 (CA); and note also the observations of Lord Nicholls of Birkenhead in *Scandecor Development AB v Scandecor Marketing AB* [2001] UKHL 21; [2002] F.S.R. 7 (HL) at paras.[42] to [44]. **This allows the collectively owned goodwill to devolve by succession upon continuing members of the alliance down to the point at which the membership falls below two, when ‘the last man standing’ becomes solely entitled to it in default of any other entitlement in remainder**: see, for example, *VIPER Trade Mark* (BL O-130-09; 13 May 2009) (Appointed Person, Professor Ruth Annand).

28 These principles were fully analysed and explained in the context of a claim concerning the distribution of the assets of an unincorporated association in the judgment of Lewison J. in *Hanchett-Stamford v Attorney General* [2008] EWHC 330 (Ch.); [2009] Ch. 173 at paras.[28] to [50]. At para.[47] he provided the following summary:

47. The thread that runs through all these cases is that the property of an unincorporated association is the property of its members, but that they are contractually precluded from severing their share except in accordance with the rules of the association; and that, on its dissolution, those who are members at the time are entitled to the assets free from any such contractual restrictions. It is true that this is not a joint tenancy according to the classical model; but since any collective ownership of property must be a species of joint tenancy or tenancy in common, this kind of collective ownership must, in my judgment, be a subspecies of joint tenancy, albeit taking effect subject to any contractual restrictions applicable as between members. In some cases (such as *Cunnack v Edwards* [1895] 1 Ch. 1 489; [1896] 2 Ch. 679) those contractual restrictions may be such as to exclude any possibility of a future claim. In others they may not. The cases are united in saying that on a dissolution the members of a dissolved association have a beneficial interest in its assets, and Lord Denning MR goes as far as to say that it is a “beneficial equitable joint tenancy”. I cannot see why the legal principle should be any different if the reason for the dissolution is the

permanent cessation of the association's activities or the fall in its membership to below two. The same principle ought also to hold if the contractual restrictions are abrogated or varied by agreement of the members. . . .

I believe that this reasoning helps to clarify some of the obscurities in the case law relating to the acquisition, retention and elimination of interests in collectively owned goodwill noted and discussed in Wadlow *The Law of Passing Off* (3rd Edn, 2004) paras.3-104 to 3-185.

23) It is clear, and does not seem to be in dispute, that the membership of the band varied over even the initial years. To my mind, the members of the band were members of an alliance of the kind described by Mr Hobbs QC in paragraph [27] of the CLUB SAIL decision (above), and therefore there was a collectively owned goodwill.

24) It follows that when members ceased to be members of Band they ceased to have any interest in the collectively owned goodwill in the mark, Cupid's Inspiration, subject to the terms of any contractual arrangements between them; and the collectively owned goodwill in the mark, Cupid's Inspiration, would devolve by succession upon continuing members of the Band down to the point at which the membership fell below two, when 'the last man standing' would become solely entitled to it in default of any other entitlement in remainder.

25) There is no evidence of any relevant contractual arrangements between the parties. The history of the band and its members was set out in the submissions of Mr Everett and seems to agree, broadly, with what SPT also claimed, although some minor differences were given. The following appears to be a reasonably accurate picture:

1961: Jet Black and the Vampires: (Members not stated).

1962: Terry Young Four: (members not stated).

1963: The Blue Sounds: (Rice-Milton, Laughton, Peck T, Peck K. & Sharp).

1963: The Loose Ends: (Rice-Milton, Laughton, Peck T. & Sharp).

1964: The Loose Ends: (Rice-Milton, Laughton, Peck T. & George).

1965: The Ends: (Rice-Milton, Laughton, Peck T, George).

1965: The Ends: (Rice-Milton, Laughton, George & Gray).

1966: The Age of Consent: (Rice-Milton, Laughton, George & Gray).
1966: Age with T, Rice-Miller: (Rice-Milton, Laughton, George & Gray).
1968: Cupid's Inspiration: (Rice-Milton, Laughton, George & Gray).
1968: Cupid's Inspiration: (Rice-Milton, Laughton, George, Gray & Tonkin).
1968: Cupid's Inspiration: (Rice-Milton, George, Gray & Tonkin).
1969: Cupid's Inspiration: (Rice-Milton, Gray, Lee & Needham).
1970: Cupid's Inspiration: (Rice-Milton, Gray Lee, Needham & Haskell).
1970: Cupid's Inspiration: (Lynch, Hawkswood, Needham & Gray).
1971: Cupid's Inspiration: (Cure, Shanahan, Poole & Gray).
1972 - 1981: Cupid's Inspiration: (Cure, Carr, Poole & Chaplin).
1981 - 1987: Cupid's Inspiration: (Cure, Shanahan, Poole & Brooke).
1987-2003/4: Cupid's Inspiration: (Cure, Hancock, Poole & Duggan).
2010: Cupid's Inspiration: (Shanahan, Poole, Thomas & Unknown).
2014: Cupid's Inspiration: (Shanahan, Poole, Thomas & Gray).

26) Although there are some differences between the two parties' recollection of line-ups over the years, there is agreement that Mr Laughton left in 1968, Mr Rice-Milton left in 1970 and the band replaced them and continued playing until at least 1987 with changes of personnel at regular intervals along the way. Therefore, the band was not brought to an end as was the case in the Animals and so the "last man standing" does not occur. Instead Mr Laughton in 1968, and Mr Rice-Milton in 1970, relinquished their membership of the band. The other band members at the time continued and did not relinquish their membership. Between 1970 and 2003 the band continued to trade, playing live shows in the UK and Europe. They may have been considered a pub band or tribute band by some, but it is undeniable that they were active under the name Cupid's Inspiration. The only time the band ceased to function was in the period 2003-2010 following the retirement of the vocalist Mr Cure. However, in 2010 Mr Poole who was in the band at the time of Mr Cure's retirement decided to bring the band out of retirement and contacted others who had previously also been in the band for a number of years. The collective goodwill stayed with the band and by leaving in 1968 and 1970 respectively Mr Laughton and Mr Rice-Milton relinquished any rights they may have had in the collective goodwill.

27) As the ground of invalidity requires RML to show that they have a protectable goodwill in the mark in order to succeed, the invalidity action based upon section 5(4)(a) must fail.

28) I now turn to the sole ground of opposition in respect of application 3262441, which is based upon section 5(2)(b) which reads:

“5.-(2) A trade mark shall not be registered if because -

(a)

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

29) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“6.-(1) In this Act an "earlier trade mark" means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

30) The opponent is relying upon its trade mark listed in paragraph 3 above which is clearly an earlier trade mark, and following the failure of the invalidity action earlier in this decision is validly registered. The mark in suit was published on 15 December 2017 at which point the opponent’s mark had not been registered for over five years. Therefore, the proof of use requirements do not bite.

31) When considering the issue under section 5(2)(b) I take into account the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The average consumer and the nature of the purchasing decision

32) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

33) The services at issue in these proceedings are, broadly speaking, live performances of music. The average consumer for such services will be the public at large. The services will be advertised through the traditional print media, social media radio, television, the internet, posters and flyers. Tickets for such events will usually be purchased from the venues concerned or from ticket agencies either in person, by telephone or via the internet. The selection process is likely to be predominantly a visual one; but given the potential interaction with staff at the venue or on the telephone, aural considerations cannot be overlooked. Turning now to the level of attention the average consumer will display when selecting the services given that for the most part the cost of the services is likely to be relatively low, but bearing in mind that the average consumer will wish to ensure they are selecting

the type of music they prefer and/or the particular group they enjoy listening to they are, in my view, **likely to pay at least a reasonable level of attention to the selection of the services at issue.**

Comparison of services

34) In the judgment of the Court of Justice of the European Union (CJEU) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

35) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (GC) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

36) In *YouView TV Ltd v Total Ltd* ,[2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is

equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

37) In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations"... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context."

38) In the instant case the services of the two parties are as follows:

SPT's services	RML's services
Class 41: Entertainment in the form of live musical performances; entertainment and musical services; production of music shows; production of musical works in a recording studio; recording of music; band performances.	Class 41: Music concerts; Music entertainment services; Music festival services; Music performance services; Music performances; Music production; Musical concerts by radio; Musical concerts by television; Musical entertainment; Musical group entertainment services; Musical performances.

39) **It is clear that the services of SPT encompass those of RML and so the services are identical.**

Comparison of trade marks

40) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

".....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of

the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

41) It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by them. The trade marks to be compared are:

RML's trade mark	SPT's trade mark
The Original Cupid's Inspiration	Cupids Inspiration

42) I note that in *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, the CJEU found that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in *Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)”.

43) Visually, both marks share the same highly distinctive element of the words “cupids inspiration”. The presence or absence of the apostrophe will not, in my mind, register with most consumers, The only difference between the marks are the words “The Original” which are present in RML’s mark. I accept that these appear at the start of the mark which is usually more important, however the word “The” does not in and of itself have any distinctiveness unless used in a highly unusual manner which is not the case here. The next word “original” suggests that the subject matter was the first version of the product, or in this case the original band. However, given that the “original band” which went under the name cupids inspiration lasted for a few short months in 1968 it is highly doubtful if, given their low profile even at the height of their fame, which petered out by 1970, anyone other than geeks and die-hard fans would remember who was in the band fifty years on. The majority of the public were not born at the time, and have probably no idea who or what the band were or are. Clearly, the marks are visually similar to at least a medium to high degree.

44) Aurally, there are clear differences, but these are elements that will be given little attention by the average consumer. There is a medium to high degree of aural similarity.

45) Conceptually, both marks refer to Cupids Inspiration which is an inventive name and highly unusual. The use of the words “The Original” does not have much conceptual significance other than to imply it is the first version. The marks are conceptually similar to a high degree.

46) Overall, I believe that the marks have a medium to high degree of similarity.

Distinctive character of the earlier trade mark

47) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

48) SPT’s mark consists of two words which are well known words individually but when combined give a highly distinctive image. To my mind, **it has a medium to high degree of inherent distinctiveness**. SPT have been using the mark for a number of years but clearly in a relatively small way, playing pubs, holiday camps etc. Whilst they clearly have a protectable goodwill it is not sufficient for them to **benefit from an enhanced degree of distinctives through use in relation to the services for which it is registered**.

Likelihood of confusion

49) In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark as the more distinctive the trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision, I concluded that:

- the average consumer for the services is a member of the general public who will select the services by predominantly visual means, although I do not discount aural considerations and that they are likely to pay at least a reasonable degree of attention to the selection of the services.

- the marks of the two parties have a medium to high degree of similarity.
- the opponent's mark has a medium to high degree of inherent distinctiveness but cannot benefit from an enhanced distinctiveness through use.
- the services of the two parties are identical.

50) In view of all of the above, and allowing for the concept of imperfect recollection, there is a likelihood of consumers being directly confused into believing that the services applied for and provided by RML are those of SPT or provided by an undertaking linked to it. **The opposition under Section 5(2) (b) therefore succeeds in respect of all the services.**

CONCLUSION

51) The invalidity action under section 5(4)(a) failed. The opposition under sections 5(2)(b) is successful.

COSTS

52) SPT has been successful in defending its mark against the invalidity action and successful in its opposition to RML's application. It is therefore entitled to a contribution towards its costs. SPT provided a cost pro-forma which shows they incurred cost of £834. The breakdown of activities shows that the time spent is perfectly reasonable for private litigants and the costs on professional advice also very reasonable.

53) I order Terry Rice-Milton and James Laughton to pay Paul Shanahan, Robert Poole and Paul Thomas jointly the sum of £834. This sum to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 12th day of September 2019

**George W Salthouse
For the Registrar,
the Comptroller-General**